



IPR IN THE GLOBAL ECONOMY

INTERNATIONAL SYSTEMS: MADRID, HAGUE, LISBON

ERNESTO RUBIO | 12th July 2021



CARIFORUM



EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

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IPR IN THE GLOBAL ECONOMY

Three international systems that facilitate IPR protection at the international level

- The Madrid Protocol trademarks
- The Hague Agreement industrial designs
- The Lisbon Agreement appellations of origin and geographical indications

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

- A brand protection system in full expansion ... today available to nationals of 124 States
- A business competitiveness tool ... of special interest to export industries
- A balanced and flexible legal instrument ... respectful of the sovereignty of each of its Members
- A trademark protection route increasingly used by all types of companies ... and particularly attractive for SMEs

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

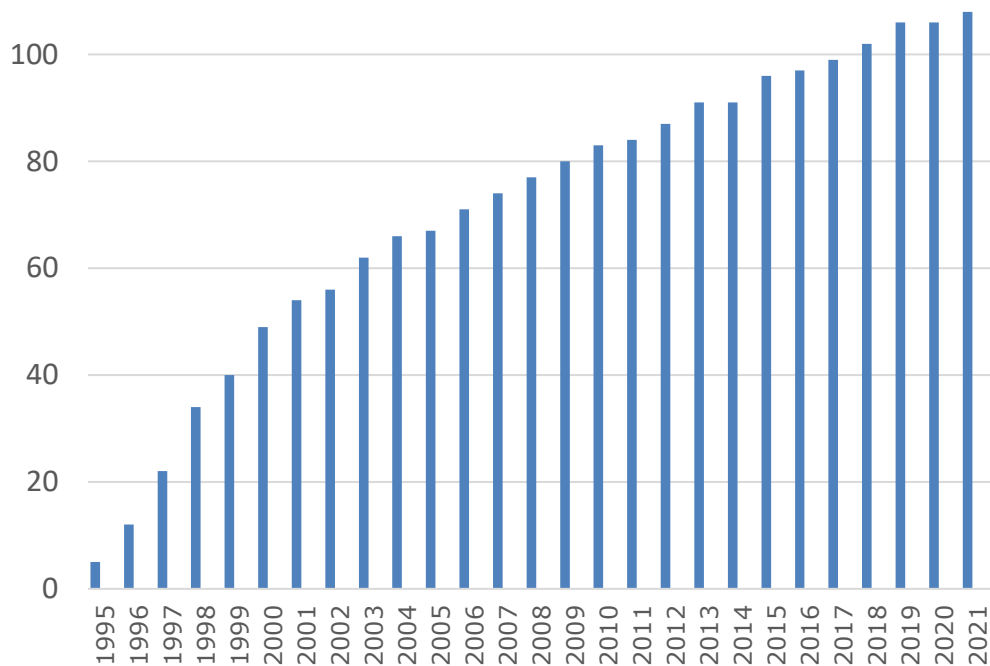
A brand protection system in full expansion
today available to nationals of 124 States

A SYSTEM AVAILABLE TO NATIONALS OF ITS MEMBERS

The Madrid system can only be used by persons who have

- an attachment to a Contracting Party
 - nationality, or
 - domicile, or
 - industrial or commercial establishment
- and
- a basic mark in that Contracting Party
 - a TM application or a TM registration at the relevant Office

THE MADRID PROTOCOL – A SYSTEM IN FULL EXPANSION (Dec 1995 – Jul 2021)

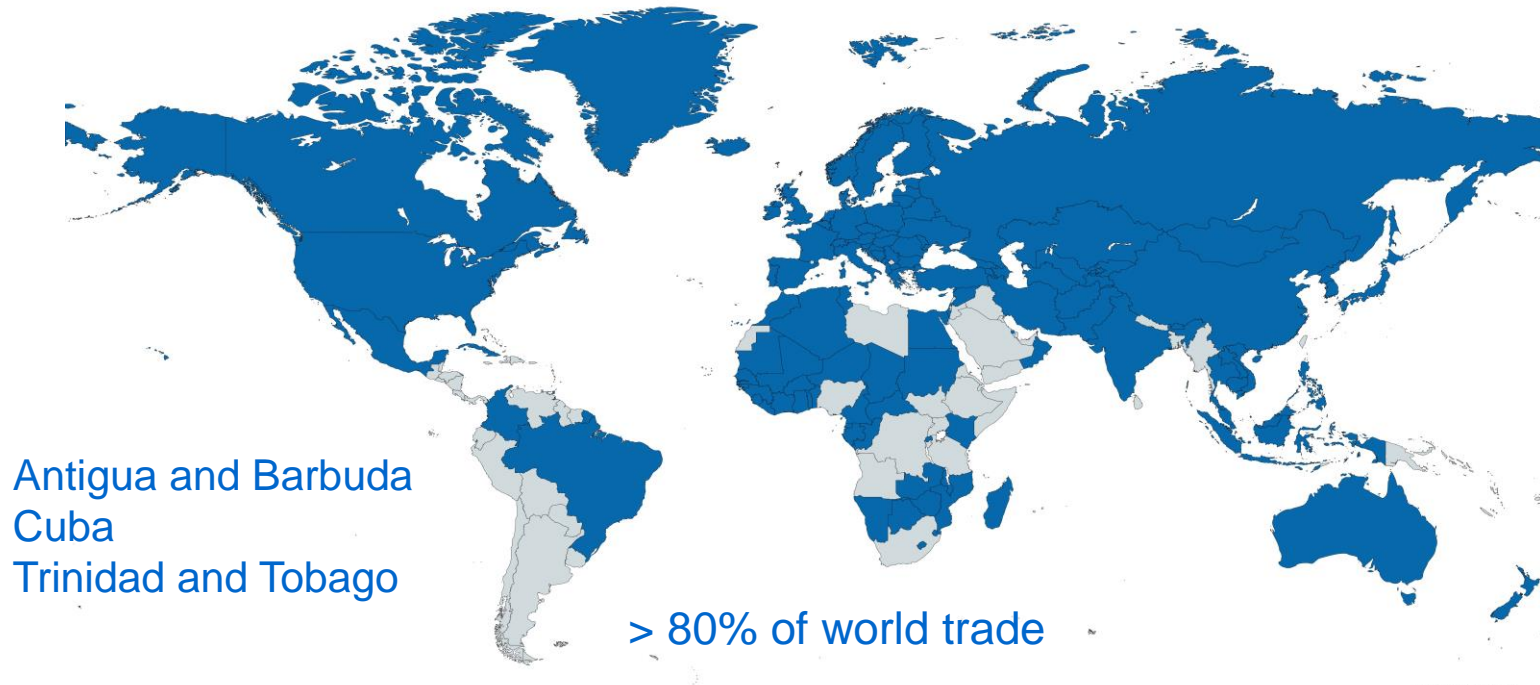


108 Members
(Contracting Parties)

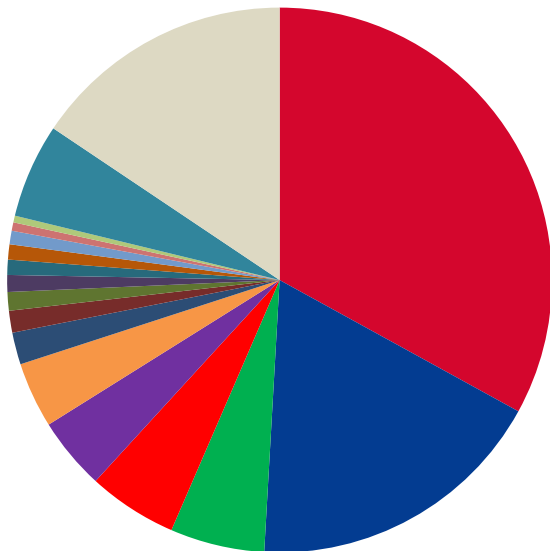
106 States
+ 2 intergovernmental
organizations

- European Union (27 States)
- OAPI (17 States)

MADRID GEOGRAPHICAL COVERAGE 108 Members = 124 countries (by July 2021)



MADRID UNION MEMBERS – AN ATTRACTIVE MARKET FOR CARIBBEAN EXPORTS



More than 84% of products exported by CARIFORUM countries go to Madrid Union Members ...

... about half of them to the United States (33%) and the European Union (17.9%) ...

... Switzerland, China, Canada and Trinidad and Tobago. Also, to India, UK, Mexico, ROK, Brazil, Japan, Colombia, Singapore and the Russian Federation, etc.

Becoming a Party to the Madrid Protocol would offer to CARIFORUM nationals the possibility to obtain easier trademark protection in those markets

■ US
 ■ EU
 ■ CH
 ■ CN
 ■ CA
 ■ TT
 ■ IN
 ■ GB
 ■ MX
 ■ KR
 ■ BR
 ■ JP
 ■ CO
 ■ SG
 ■ RU
 ■ other Madrid
 ■ non-Madrid

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

A business competitiveness tool
of special interest to export industries

THE MADRID PROTOCOL – MAIN OBJECTIVES

- Facilitate brand protection abroad, in export markets ...
- ... and lower the costs that entrepreneurs have to pay to obtain and maintain such protection

As a result, the Protocol helps entrepreneurs to

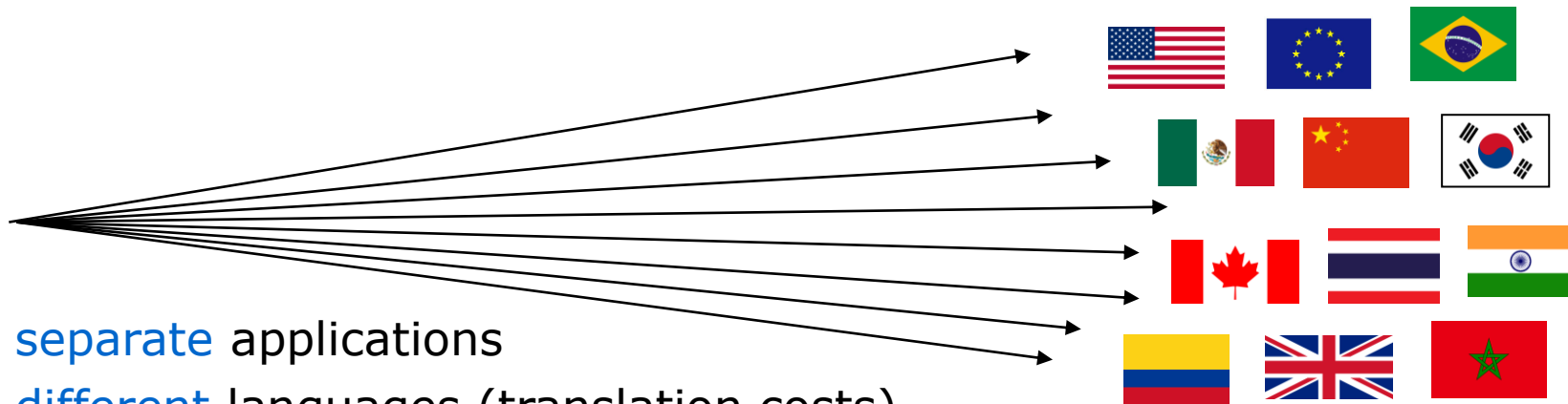
- export branded products/services
- add value to their exports
- improve their international competitiveness

HOW DOES THE PROTOCOL ACHIEVE THOSE OBJECTIVES?

By offering a **simple, expedite** and **cost-effective** set of procedures for entrepreneurs to

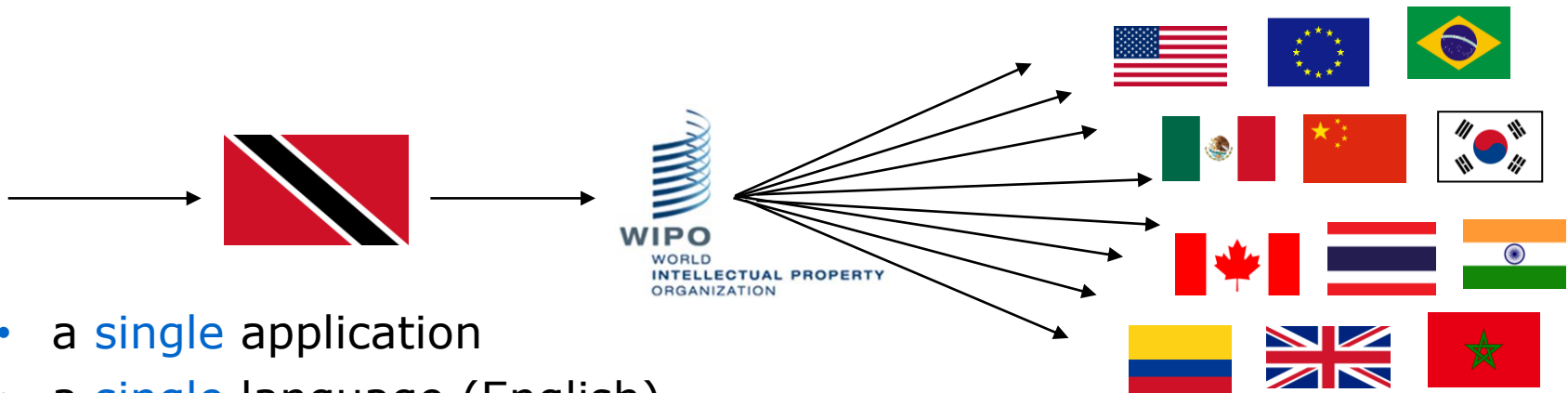
- apply for the legal protection of their brands in export markets
= **central filing of trade mark applications**
- manage their trade mark rights valid in various countries
= **central management of trade mark registrations**

TRADITIONAL FILING VS MADRID CENTRAL FILING



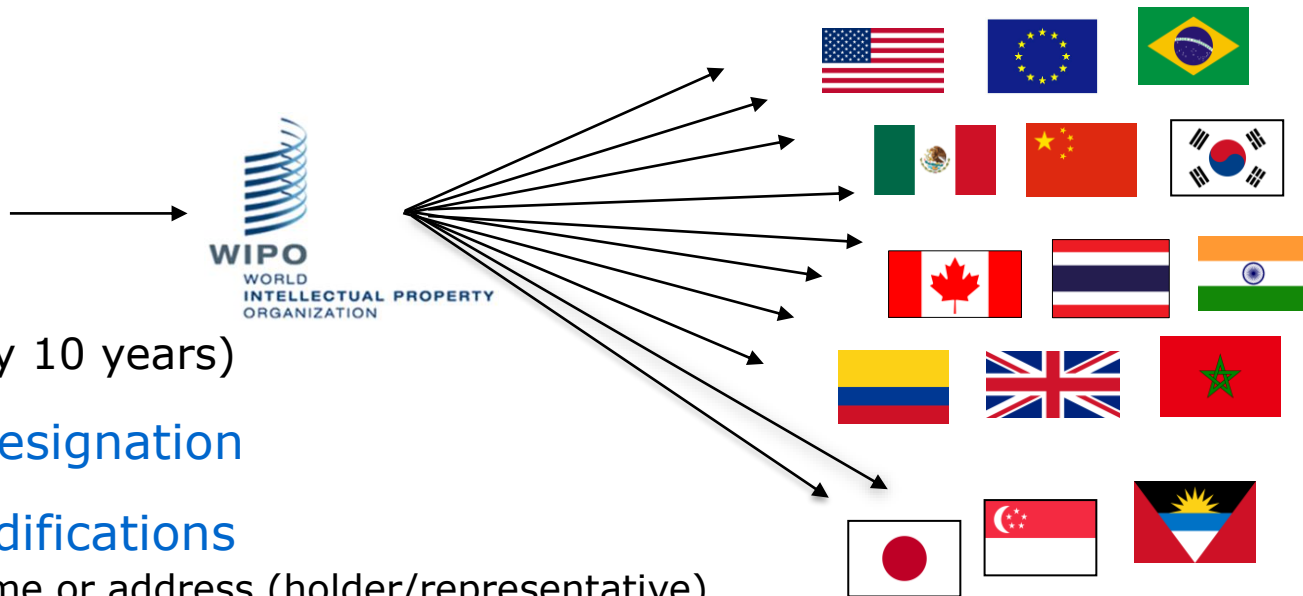
- **separate** applications
- **different** languages (translation costs)
- fees paid in **different** local currencies (currency exchange costs)
- local representative **frequently required** (additional costs involved)
- **different** procedures from the start with **different timeframes**

TRADITIONAL FILING VS MADRID CENTRAL FILING



- a **single** application
- a **single** language (English)
- fees paid in a **single** currency (CHF)
- local representative **required only in limited cases**
- a **single** international procedure and **strict deadlines** for the rest

MADRID CENTRAL MANAGEMENT



- renewal (every 10 years)
- subsequent designation
- recording modifications
 - a change of name or address (holder/representative)
 - assignment of rights (partial or total change in ownership)

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

A balanced and flexible legal instrument
respectful of the sovereignty of each of its Members

THE MADRID SYSTEM LEGAL FRAMEWORK

- [Madrid Protocol 1989](#) – Diplomatic Conference
- [Common Regulations](#) – Madrid Union Assembly (Feb 1, 2021)
- [Administrative Instructions](#) – International Bureau (Feb 1, 2021)
- [Laws and Regulations of each Madrid Union Member](#)

THE MADRID SYSTEM LEGAL FRAMEWORK

Each Designated Contracting Party decides ...

- whether it corresponds or not to confer trademark protection to a given IR under the Madrid Protocol, and
- in accordance with its own substantive trademark law provisions

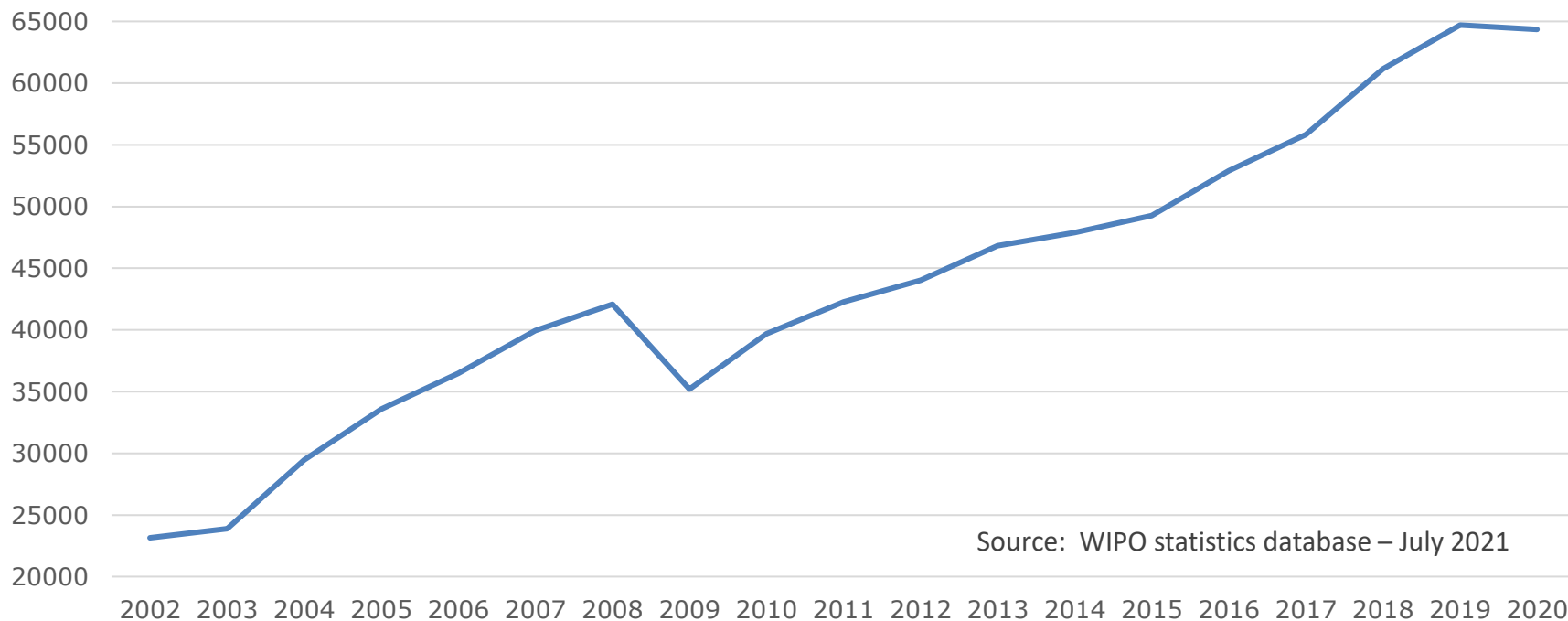
DCPs may refuse protection within

- 12 months or
- 18 months or
- 18+ months in case of opposition

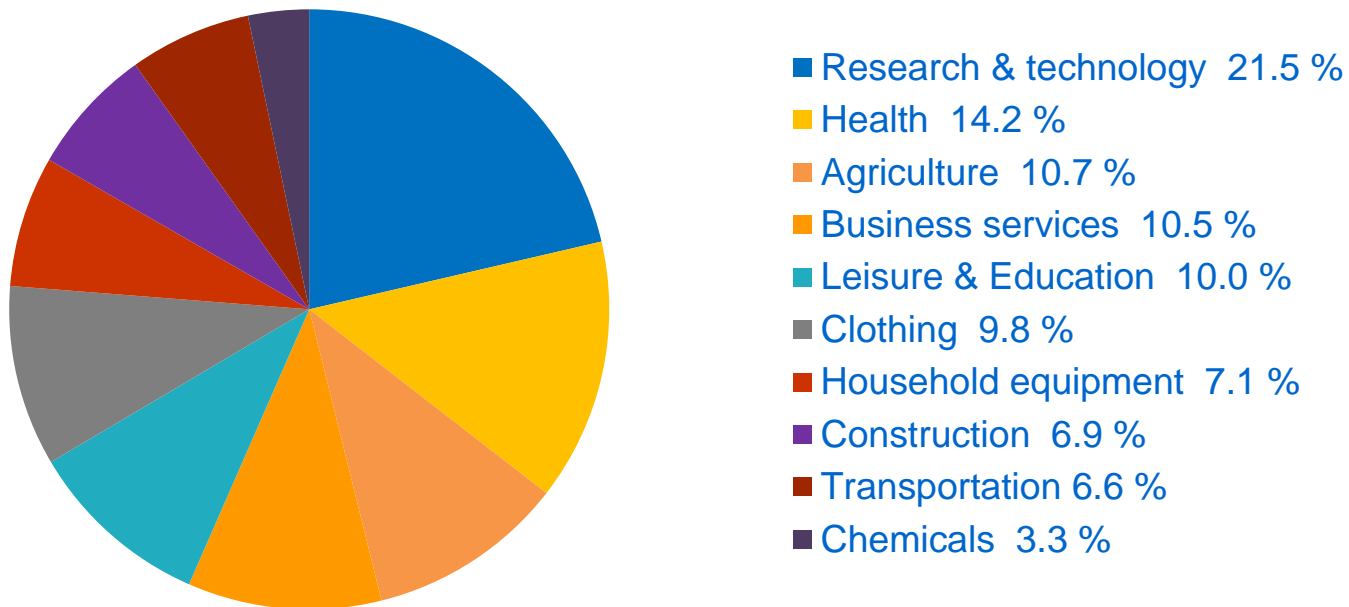
THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

A trademark protection route increasingly used by
all types of companies ...
and particularly attractive for SMEs

THE MADRID PROTOCOL : A GROWING NUMBER OF APPLICATIONS (2002-2020)



MADRID PROTOCOL : USERS FROM A VARIETY OF INDUSTRY SECTORS (2020)



Source: Madrid Yearly Review 2021 - WIPO publication No. 940E/21

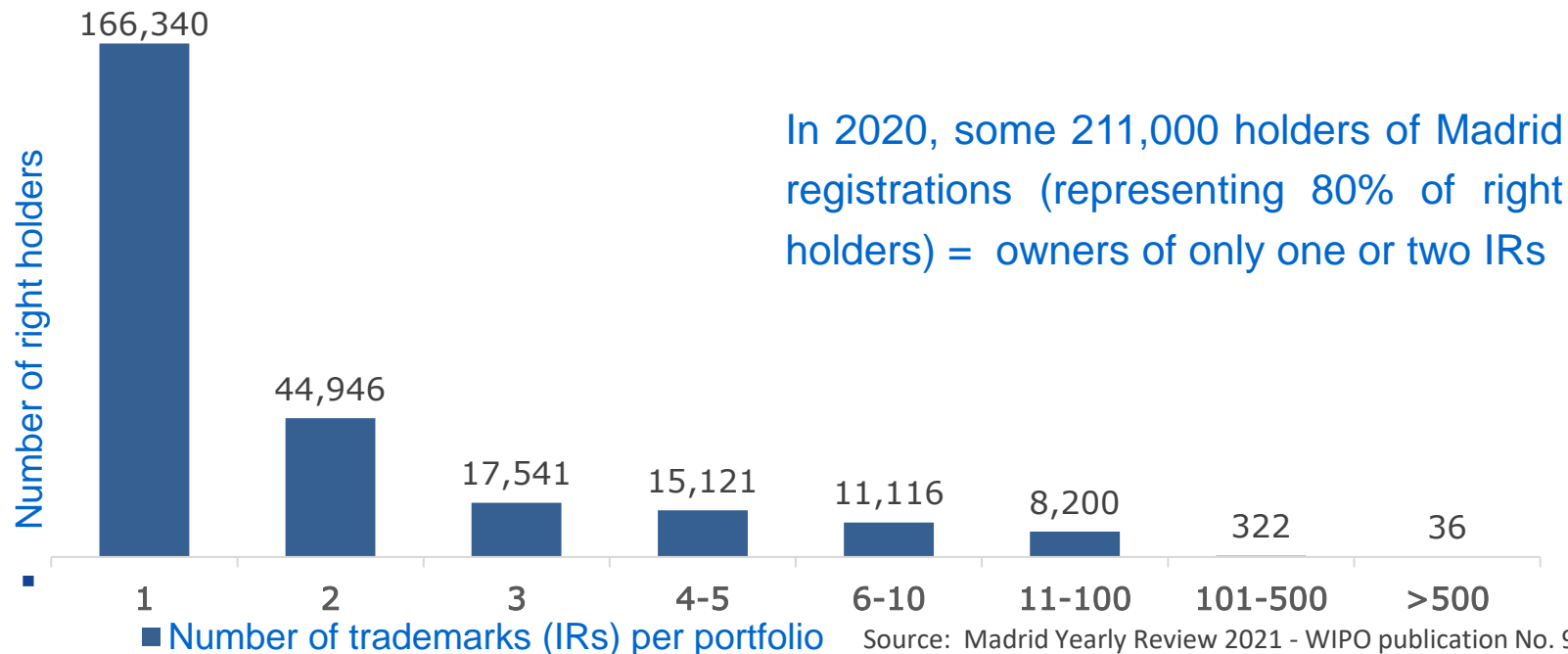
MADRID PROTOCOL : A COST EFFECTIVE PROTECTION SYSTEM (2020 PROFILE)

64,356 international applications

Average n° of designations	7.1
Average number of classes	2-3
Average fee paid per registration	CHF 3,392
50% of registrations paid	CHF 2,390 or less

Source: Madrid Yearly Review 2021 - WIPO publication No. 940E/21

MADRID PROTOCOL : PARTICULARLY USEFUL FOR SMEs



THE HAGUE SYSTEM : AN ATTRACTIVE ROUTE TO PROTECT DESIGNS GLOBALLY

Industrial Designs

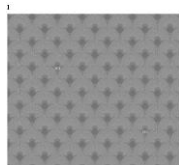
protecting the outward appearance of a product or part of it



DM/103819



DM/103348



DM/103232



DM/103030



DM/103609

THE HAGUE SYSTEM

The Hague System

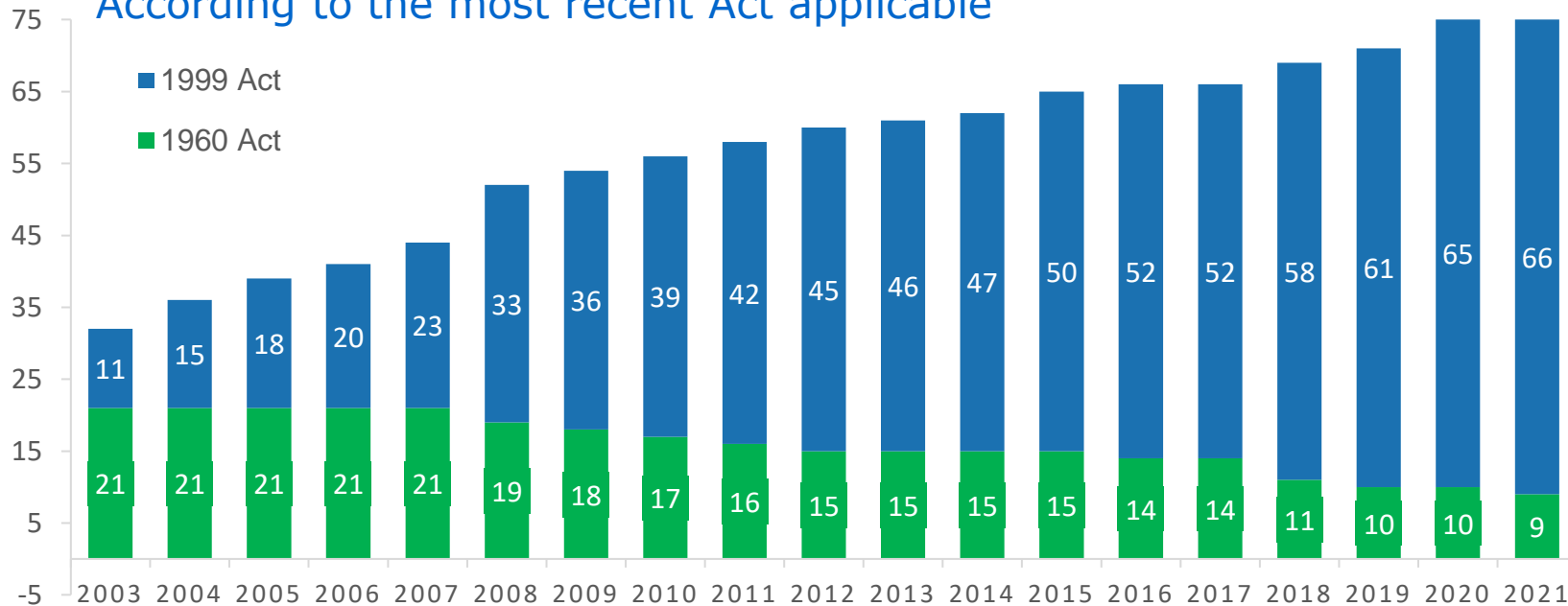
- aims at facilitating the protection of industrial design rights in up to **75 Contracting Parties** (States and IGOs) ...
- ... through **a single international application** that results in ...
- ... **a single international registration** with individual effects in each Contracting Party designated therein

Two autonomous and independent treaties:

- Hague Act of the Hague Agreement (**1960 Act**) – **34 Members (only States)**
- Geneva Act of the Hague Agreement (**1999 Act**) – **66 Members (States + IGOs)**

THE HAGUE SYSTEM EXPANSION SINCE 2003

According to the most recent Act applicable



HAGUE AGREEMENT MEMBERSHIP IN JULY 2021

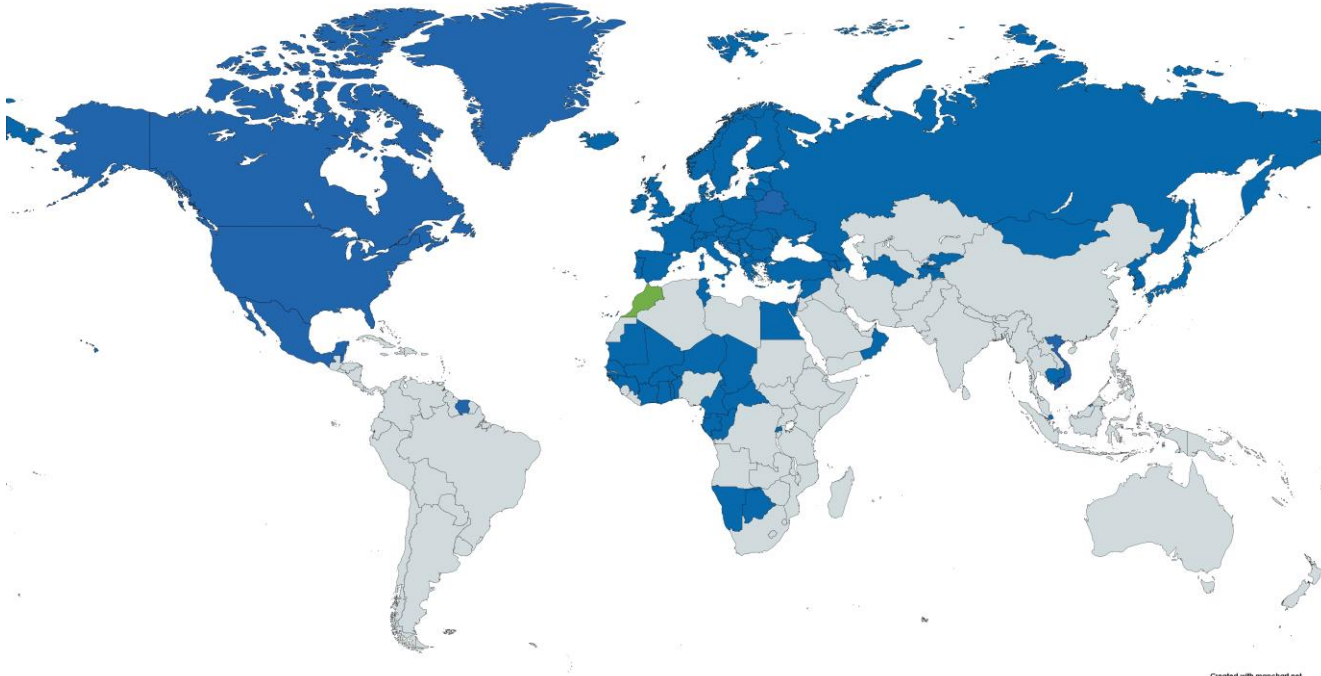
Grouped according to the most recent Act applicable

Geneva Act (1999 Act): [African Intellectual Property Organization](#), Albania, Armenia, Azerbaijan, Belarus, Belgium, **Belize**, Bosnia and Herzegovina, Botswana, Brunei Darussalam, Bulgaria, Cambodia, Canada, Croatia, DPRK, Denmark, Egypt, Estonia, [European Union](#), Finland, France, Georgia, Germany, Ghana, Hungary, Iceland, Israel, Japan, Kyrgyzstan, Latvia, Liechtenstein, Lithuania, Luxembourg, Mexico, Monaco, Mongolia, Montenegro, Namibia, Netherlands, North Macedonia, Norway, Oman, Poland, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Rwanda, Samoa, San Marino, Sao Tome and Principe, Serbia, Singapore, Slovenia, Spain, **Suriname**, Switzerland, Syrian Arab Republic, Tajikistan, Tunisia, Turkey, Turkmenistan, Ukraine, United Kingdom, United States of America, Vietnam ([66 Contracting Parties](#))

Hague Act (1960 Act): Benin, Côte d'Ivoire, Gabon, Greece, Italy, Mali, **Morocco**, Niger, Senegal
(9 Member States)

HAGUE SYSTEM COVERAGE

75 Members = 92 countries (in July 2021)

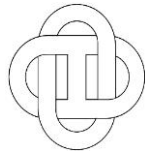


HAGUE SYSTEM : AN ATTRACTIVE ROUTE TO PROTECT DESIGNS GLOBALLY

How does the Hague System work ?



DM/083330



DM/081718



DM/083137



DM/089858

WHO IS ENTITLED TO USE THE HAGUE SYSTEM ?

The Hague System can be used by anyone who has

- an attachment to a Contracting Party
 - industrial or commercial establishment, or
 - nationality, or
 - domicile, or
 - habitual residence

- Unlike Madrid
- the applicant does not need to have a “basic design” in that Contracting Party
 - moreover, the applicant may designate its own Contracting Party for protection

TRADITIONAL FILING vs HAGUE CENTRAL FILING



- a **single** application
- a **single** language (English, French or Spanish)
- **fees** paid in a **single** currency (**CHF**)
- local representative **only required in limited cases**
- a **single** international procedure and **strict deadlines** at DCPs

HAGUE SYSTEM – INTERNATIONAL APPLICATION, FILING, FEES

- **Application**
 - up to 100 designs + their reproductions or specimens
 - products (in one Locarno class)
 - identity of the creator (required by some DCPs)
- **Filing at WIPO** - can be done electronically - **E-filing** interface
- **Fees (CHF)** (example)
 - one IA, one design, one reproduction, designating BZ, SR, **EM**, GB, CH (for protection in 31 countries)
 - basic fee **397**, publication fee **17**, designation fees **253**

Total 667 CHF

- if CA (**288**) & US (**989**) are also designated

1,944 CHF

HAGUE SYSTEM : EFFECTS OF THE INTERNATIONAL REGISTRATION

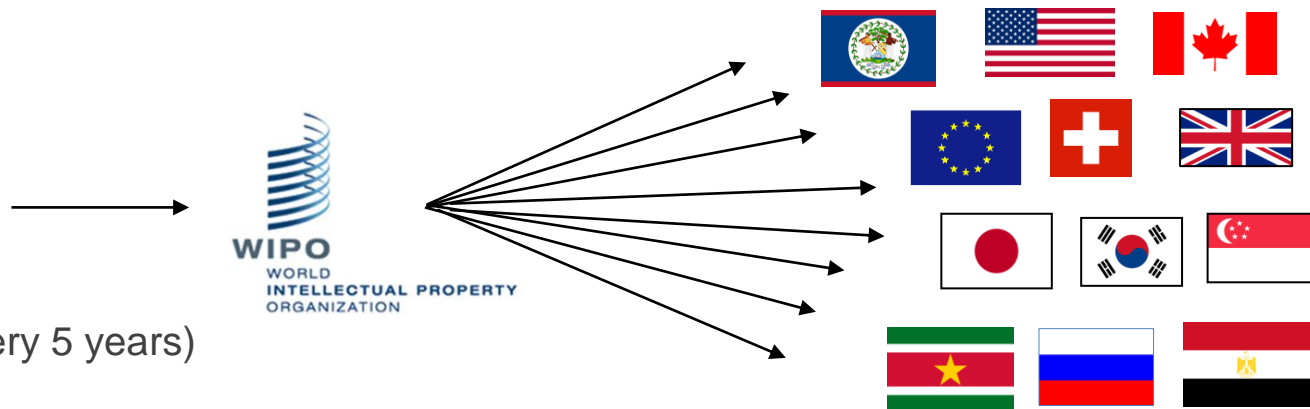
Each designated Contracting Party (DCP) decides ...

- whether it corresponds or not to confer industrial design protection to a given IR in accordance with its own substantive industrial design law provisions
- the DCP has to do so within **strict time limits**: 6 or 12 months from publication of the design in the *International Designs Bulletin*

IR Effects

In all those DCP that have not refused protection within those time limits, the international registration has the same effects as a **registration of a duration of 5 years** recorded by the Office of that CP, **renewable** (for additional periods of 5 years)

HAGUE CENTRAL MANAGEMENT



- **renewal** (every 5 years)
- **modifications**
 - changes in name or address (holder/representative)
 - assignments (change in ownership)

HAGUE SYSTEM : DURATION OF PROTECTION

Duration of protection under the 1999 Act

- minimum 15 years
- may be longer depending on the legislation of each DCP

15 years (26 Members)

20 years (1 Member)

25 years (38 Members)

50 years (1 Member)

THE LISBON SYSTEM

Appellations of origin and geographical indications

APPELATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS

Geographical Indication (GI)

- a sign (not necessarily a denomination)
- used on products of a specific geographical origin
- qualities, reputation or characteristics essentially attributable to that place

Appellation of Origin (AO) – a special type of geographical indication (GI)

- the geographical denomination of a country, region or locality
- serves to designate a product originating therein,
- quality or characteristics due exclusively or essentially to the geographical environment including
 - natural factors – soil and climate and
 - human factors – e.g., method of production or manufacture

a stronger qualitative connection between product and place of origin

HOW DO YOU GET PROTECTION FOR AOs and GIs ?

Nationally

- sui generis regimes
 - special statute
 - registration as AO or GI
- collective or certification marks

Abroad

- bilateral agreements
 - mutual recognition of certain GI
- national- or regional-level registration as AO, GI or collect/certific. mark
- international registration
 - Lisbon System

THE LISBON SYSTEM

Two autonomous and independent treaties:

- Lisbon Agreement (1958) revised in Stockholm (1967)
 - international protection of appellations of origin (AO)
 - 30 members (States)
- Geneva Act of the Lisbon Agreement (2015)
 - international protection of appellations of origin (AO) and geographical indications (GI)
 - 9 Contracting Parties (including the EU) with effects in the territories of 33 countries

any country may be a Party to both treaties

LISBON UNION MEMBERS

Members of the Lisbon Union:

- Geneva Act 2015 – 9 Contracting Parties = 33 countries

Albania, Cambodia, DPRK, [European Union](#), France, Hungary, Lao PDR, Oman, Samoa

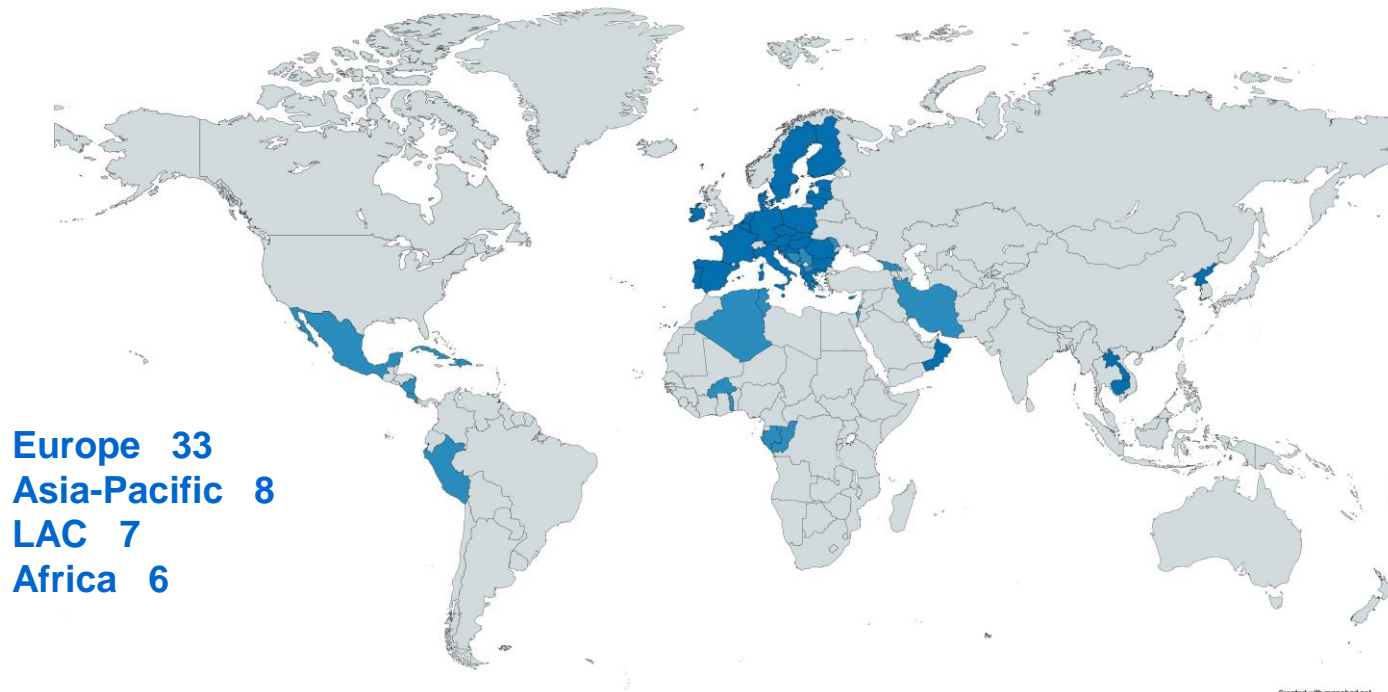
- Lisbon Agreement (1958 Act + 1967 Act) – 30 Member States

Albania, Algeria, Bosnia and Herzegovina, Bulgaria, Burkina Faso, Congo, Costa Rica, [Cuba](#), Czech Republic, [Dominican Republic](#), DPRK, France, Gabon, Georgia, [Haiti](#), Hungary, Iran, Israel, Italy, Mexico, Montenegro, Nicaragua, Northern Macedonia, Peru, Portugal, Republic of Moldova, Serbia, Slovakia, Togo, Tunisia

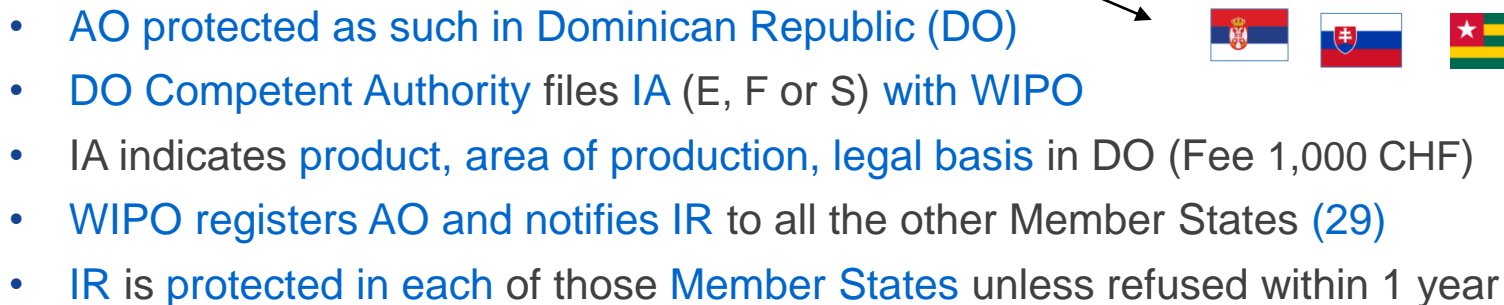
Lisbon System overall geographical coverage = 54 countries

LISBON SYSTEM GEOGRAPHICAL COVERAGE

54 countries (in July 2021)



Created with mapchart.net



LISBON AGREEMENT – INTERNATIONAL PROTECTION

Refusal of protection – must specify the grounds

- For example
- generic character of the denomination
 - conflict with an earlier right

Content of protection - against any usurpation or imitation of the AO,

- even if the true origin of the product is stated, or
- if the AO is used in translated form or
- if used accompanied by terms such as “kind”, “type”, “make”, “imitation” and the like

Term of protection - indefinite as long as the AO is protected in C. of Origin

THE GENEVA ACT OF THE LISBON AGREEMENT (2015)

Geneva Act allows flexible means of protection

CPs may ensure protection through **any type of legislation** (*sui generis* law, trademark law, administrative provisions, other legal means) provided that they meet the requirements of the Geneva Act

Protection of third party rights

Whoever could be affected can request the national CA to notify a refusal of protection (e.g., based on prior trademark rights, generic character, etc.)

Additional flexibilities – CPs may declare their intention to request:

- the payment of **an individual fee**
- a declaration of **intention to use** the AO or GI

MADRID PROTOCOL, HAGUE 1999 ACT, LISBON GENEVA ACT

Are these treaties
of interest to the Caribbean countries ?

CARIBBEAN TRADEMARKS

Are there many Caribbean companies wishing
to protect their marks abroad?

TRADEMARK FILINGS BY CARIBBEAN COMPANIES ABROAD 2010-2019 = 28,013

TRADEMARK FILINGS BY ORIGIN OF THE APPLICANT

COUNTRY	TOTAL	COUNTRY	TOTAL
Bahamas	6,771	St Kitts and Nevis	594
Barbados	6,104	Antigua and Barbuda	569
Belize	5,029	Dominica	520
Dominican Republic	2,807	Suriname	279
Cuba	2,737	St Vincent & the Grenadines	187
Jamaica	832	Guyana	115
Saint Lucia	767	Haiti	107
Trinidad and Tobago	626	Grenada	59

Source: WIPO statistics database – July 2021

TRADEMARK FILINGS BY CARIBBEAN COMPANIES ABROAD 2010-2019 = 28,013

TOP DESTINATIONS

COUNTRY	TOTAL	COUNTRY	TOTAL
United States of America	3,821	Colombia	720
European Union	1,704	United Kingdom	649
Russian Federation	1,380	India	626
China	1,356	Japan	561
Mexico	1,237	Costa Rica	546
Canada	938	El Salvador	534
Brazil	832	Australia	504
Panama	746	Argentina	494

Source: WIPO statistics database – July 2021

CUBA – SOME TRADEMARKS HAVING SEEKED PROTECTION VIA THE MADRID SYSTEM



Source: WIPO Madrid Monitor – July 2021

ANTIGUA AND BARBUDA – SOME TRADEMARKS PROTECTED VIA THE MADRID SYSTEM



ARISE COLLECTIVE



KAI COLLECTIVE

ZFORT

Banking and financial services, eyewear, spectacles, corrective lenses, eye care products ...

Source: WIPO Madrid Monitor – July 2021

335 MADRID ACTIVE MARKS BY HOLDERS FROM OTHER CARIBBEAN COUNTRIES



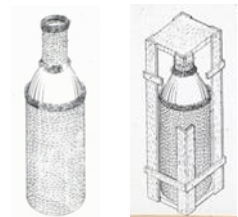
Source: WIPO Madrid Monitor – July 2021

THEY HAD TO FILE THROUGH ANOTHER COUNTRY (A MADRID UNION MEMBER)

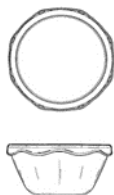
CARIBBEAN DESIGNS

Are there many Caribbean design creators
wishing to protect their designs abroad?

CARIBBEAN DESIGNS – PROTECTED ABROAD



container for alcoholic beverages
including spirits (CU)

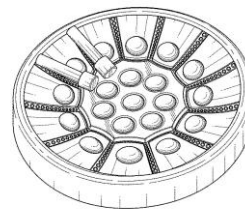


multiuse container (DM)

Fig. 1



footwear insert (BS)



steelpan magnet (TT)

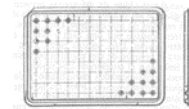
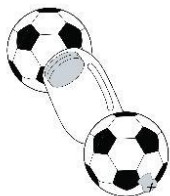
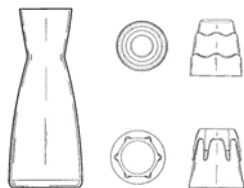


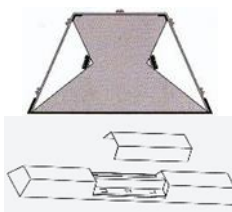
plate for multiple
analytical reactions (CU)



flasks for travellers (AG)



jug and glass set (DM)



advertising devices (DO)



advertising device for
tire barriers in parking slots (DO)

WHY NOT VIA THE HAGUE SYSTEM ?

Source: WIPO Global Design Database – July 2021

CARIBBEAN GEOGRAPHICAL INDICATIONS

Are Caribbean producers interested in getting
GI protection for their products internationally?

PROTECTION OF CARIBBEAN GEOGRAPHICAL INDICATIONS ABROAD

Some examples

- in the United States

JAMAICA BLUE MOUNTAIN COFFEE

certification mark



- in the European Union

CAFÉ DE VALDESIA from Dominican Republic, registered as PDO



Pending registration as PGI

TRINIDAD MONTSERRAT HILLS COCOA
DEMERARA RUM

CUBA (for rum)

Trinidad and Tobago
Guyana
Cuba

CARIBBEAN GEOGRAPHICAL INDICATIONS

CUBA - appellations of origin (AO)

20 AO protected under Lisbon system

Tobacco



CUBA HABANOS HABANA HABANEROS TUMBADERO
PARTIDO REMEDIOS HOYO DE MANICARAGUA SAN LUIS
VUELTA ARRIBA VUELTA ABAJO CABAÑAS EL COROJO
CUCHILLAS DE BARBACOA SAN JUAN Y MARTÍNEZ SAN VICENTE
LAS MARTINAS HOYO DE MONTERREY PINAR DEL RIO

Rums

CUBA



Coffee

ALTO LA MESETA
EL NICHU



ELGUEA

Mud



LOS PORTALES SAN DIEGO DE LOS BAÑOS **Mineral Water**

CARIBBEAN GEOGRAPHICAL INDICATIONS

DOMINICAN REPUBLIC – AO, GI, collective and certification marks

Coffee



VALDESIA (AO)



BARAHONA (AO)

JUNCALITO (AO)



MONTE BONITO (CertM)

BARRANCOLÍ (CoIM)



CACAO DOMINICANO (GI)

EL RAMONAL (GI)

LOS BEJUCOS (AO)

CONACADO (CoIM)



Cocoa



Rum RON DOMINICANO (CoIM)



CIGARRO DOMINICANO (GI)



Cigars



IMBERLITA (CoIM)



Petrified wood

ORO VERDE CAMBITA (AO)



Blue pectolite stone

LARIMAR BARAHONA (AO)

Avocados



Mangoes

MANGOS DOMINICANOS (GI)

UVAS DEL VALLE DE NEIVA (M)



Grapes

CARIBBEAN GEOGRAPHICAL INDICATIONS

GUYANA

DEMERARA RUM
Rum



DEMERARA SUGAR



Sugar

Molasses
DEMERARA MOLASSES



JAMAICA

JAMAICA BLUE MOUNTAIN COFFEE (CoIM)



Coffee

Rum



Jerk

JAMAICA JERK (GI)



JAMAICA RUM (GI)



TRINIDAD AND TOBAGO



MONTSEERRAT HILLS (PGI)



Cocoa

OTHER CARIBBEAN PRODUCTS POTENTIALLY QUALIFYING FOR GI PROTECTION

ANTIGUA AND BARBUDA



**Black
pineapple**

BAHAMAS



Cascarilla

BELIZE



Cohune oil

BARBADOS

Rum



GRENADA



Nutmeg

ST KITTS & NEVIS



Sarsaparilla

LISBON SYSTEM – PROTECTING GEOGRAPHICAL INDICATIONS

Why not protect your Caribbean GIs abroad
by becoming a member of the Lisbon System ?

Can CarIPI cooperate with CARIFORUM countries
interested in taking advantage of these treaties?

MADRID PROTOCOL, HAGUE 1999 ACT, LISBON GENEVA ACT

CarlPI is ready to work jointly with interested countries in

- identifying requirements and preparatory work needed to join these treaties
- offering pre- and post-accession training to staff involved in operations
- promoting the use of these international protection systems by national producers, design creators and entrepreneurs, especially SME, through
 - awareness raising and capacity building events
 - tailor-made promotional materials (best practices)



THANK YOU



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